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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,515	02/04/2000	Howard G. Page	1285	8911

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EXAMINER

RETTA, YEHDEGA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/498,515	Applicant(s) PAGE ET AL	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 20-23 and 25-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-8, 10-18, 20-23, 25-27 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed June 22, 2005. Claims 1-8, 10-18, 20-23, 25-27 are currently pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-18, 20-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix et al. U.S. Patent No. 6,718,551 further in view of "NDS: NDS' XTV(TM) time shifting technology empowers the viewer and the broadcaster", M2 Presswire, Sep 10, 1999, (hereinafter XTV(TM)).

Regarding claims 1 6-8, 11, 12, 16-18, 21, 22 and 26, Swix teaches selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer; inserting the selected video advertising, into the video stream that transfers the selected video content to the target viewer; caching the video advertising using user device, displaying the video advertising and the selected video content to the viewer; interface (see fig. 1&2, col. 6 line 26 to col. 7 line 51, col. 8 line 66 to col. 9 line 44, col. 11 line 23 to col. 12 line 20, col. 13 lines 9-54). Swix does not teach disabling fast-forward capability when the selected video advertising is displayed. XTV(TM) teaches a set-top-box which provides advertisers with the ability to totally prevent views from skipping ads. It would have been obvious to one of ordinary

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skill in the art at the time of the invention to disable the ability of fast-forward or skip forward in order to force the subscriber to view the commercials (see page 1).

Regarding claims 2, 13 and 23 Swix teaches inserting points in the selected video content for the selected advertisement and inserting the selected advertisement at the insertion point (see fig. 5 and col. 12 line 61 to col. 13 line 9).

Regarding claims 3, 4, 14 and 15, Swix teaches transferring the video content over first transport system and the advertising over a second transport system (see col. 13 lines 9-3).

Regarding claims 5 and 27. Swix teaches selecting the video ad based on a viewer profile for the target viewer (see col. 7 line 31 to col. 8 line 2, col. 8 line 66 to col. 9 line 44)

Regarding claims 10, 20 and 25, Swix does not explicitly teach re-displaying the selected video advertisements after rewinding the video content. It would have been obvious for Swix to re-display the same advertising since the advertisement selected is cached at the client set-top box and is inserted into the video stream, locally at a client side, and presented to the viewer.

### ***Response to Arguments***

Applicant's arguments filed June 22, 2005 have been fully considered but they are not persuasive.

Applicant argues that the prior art, Swix, does not teach selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer.

Examiner disagrees. Swix teaches collecting subscriber viewing selections, organizing and analyzing the selections and providing advertising based on the selection. Swix teaches the event list including data such as movie previews watched, movies watched, etc., and as the subscriber progresses through the pay-per-view menu screens, events (subscriber selections) are collected

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and organized into event lists. Swix teaches the event data being analyzed and the view being classified into a certain demographic group and delivers a commercial targeted for that group. Swix teaches, as an example, if the viewer watched a movie trailer for a movie about white water rafting and viewed an advertisement for outdoor adventure gear, then watched a movie trailer about a wilderness hiking disaster, after the system analyzed the event data a suitable advertisement would be a commercial for a sport utility vehicle (see col. 12 lines 21-59). Therefore, Swix teaches video advertisement that has a subject matter related to the selected video content. Applicant's specification (see page 7 lines 5-20) disclosed the same profiling and selecting ads based on the viewer profile which could indicated that the target viewer is interested for example in golf and country music and selecting video advertising related to golf and country music which is the same as the Swix's disclosed method and system.

Applicant also argues that the XTV reference is not a video-on-demand system and therefore cannot be used with Swix reference. Examiner respectively disagrees with applicant. In response to applicant's argument that prior art, XTV is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the XTV reference teaches advertiser inserting ads in a TV content selected by user which is in the field of applicant's endeavor, and is also pertinent to the particular problem with which the applicant was concerned i.e., preventing user from skipping the inserted ad.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**RETTA YEHDEGA**  
**PRIMARY EXAMINER**

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